

U.S. Patent Appln. S.N. 10/820,738
REQUEST FOR RECONSIDERATION

PATENT

Anticipation is established only if (1) all the elements of an invention, as stated in a patent claim, (2) are identically set forth, (3) in a single prior art reference. See Mehl/Biophile International Corp. v. Milgraum, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1306 (Fed. Cir. 1999) ("To anticipate, a single reference must teach every limitation of the claimed invention."). The Patent Office concedes Virtanen fails to expressly disclose the pre-kneading step of the claimed method (Official Action, page 3, lines 11-12).

An "inherent disclosure" ground for anticipation requires that the pre-kneading step of the claimed method necessarily and inevitably flow from practice of Virtanen's de-inking step. See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (Inherency must flow as a necessary conclusion from the prior art, not simply a possible one). In this case, Virtanen teaches the use of its multi-peripheral pin mill to de-ink recycled paper (Col. 2, line 63 to Col. 3, line 3). There is no indication a pre-kneading step is employed, much less that a pre-kneading step must be used in the Virtanen method.

Reconsideration and withdrawal of the anticipation rejection of claims 9-19 over Virtanen et al. are respectfully requested.

The alternative obviousness rejection of claims 9-19 over Virtanen is also traversed. As summarized above, a feature of the

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claimed method of separating a colouring agent from recycled fibre material is pre-kneading of recycled fibre material in a separate step prior to introduction of the pre-kneaded recycled fibre material together with liquid and gas or a gas mixture into a double-action impact mill.

Virtanen fails to raise a prima facie case of obviousness against the claimed method because one of ordinary skill in the art is given no disclosure, teaching or suggestion to modify this reference by adding a pre-kneading step to the de-inking method disclosed therein. More particularly, Virtanen itself provides no disclosure or suggestion to pre-knead recycled waste paper prior to separating the ink from the paper fibers in its defibrating device.

The deficiencies of Virtanen are not remedied by the additional disclosure of U.S. Patent No. 5,762,756 to Scott et al. There is no pre-breaking or pre-kneading of fibers prior to a defibrating step in Scott et al. Instead, Scott et al. teaches a single pulper disperser (illustrated as 2 in Fig. 1) for simultaneous pulping and dispersing, with no additional ink dispersion step required to form deinked paper stock (Abstract; Col. 5, lines 13-20). All of the remaining stages in Fig. 1 are non-fiber defibrators: purge screen 4, liquid cyclonic cleaner 6, coarse screen 8, fine screen 10, floatation device 12, cyclonic cleaners 14 and 16, and washer 18 (Col. 4, lines 13-63).

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Scott et al. does disclose subsequent recycling of non-defibered clumps of paper either back into pulping/dispersing station 2 or to a separate defiberator located downstream (Col. 7, lines 57-60). However, this post-treatment step relates only to clumps of non-defibered paper rather than the entire material feed. In contrast, the claimed method pre-treats all material by pre-kneading it prior to defibrating it in the mill.

In short, Virtanen, taken alone or in combination with Scott et al., fails to raise a prima facie case of obviousness against the claimed method. One of ordinary skill in the art is given no disclosure or suggestion to modify Virtanen by adding a pre-kneading step.

Reconsideration and withdrawal of the obviousness rejection of claims 9-19 over Virtanen are respectfully requested.

It is believed this application is in condition for allowance. Reconsideration and withdrawal of all rejections of claims 9-19, and issuance of a Notice of Allowance directed to claims 9-22, are earnestly requested. The Examiner is urged to telephone the undersigned should he believe any further action is required for allowance.

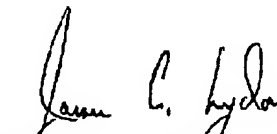
A Petition and fee for a one month Extension of Time are attached. It is not believed any additional fee is required for entry and consideration of this Request. Nevertheless, the

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Commissioner is authorized to charge our Deposit Account No. 50-1258 in the amount of any such required fee.

Respectfully submitted,



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Enclosure:
Petition for Extension of Time